



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,817	11/01/2000	Takeshi Misawa	Q61579	9981

7590 06/29/2005  
Sughrue Mion Zinn MacPeak & Seas PLLC  
2100 Pennsylvania Avenue NW  
Washington, DC 20037-3202

EXAMINER
----------

JERABEK, KELLY L

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/702,817	<b>Applicant(s)</b> MISAWA ET AL.	
	<b>Examiner</b> Kelly L. Jerabek	<b>Art Unit</b> 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 31-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 2/17/2005 have been fully considered but they are not persuasive.

### **Response to Remarks:**

Applicant's arguments (Amendment page 10) state that the Ejima reference contains a sound recording button, a release button, CLEAR, CANCEL, MENU, EXEC, and arrow buttons but not arranged as described by amended claim 1. The Examiner respectfully disagrees. Ejima discloses in figures 1-2 and 12-14 an electronic camera. The camera includes a front face (X2) (figs. 2, 12, 14) and a back (X1) (figs. 1,13) opposed to the front face. The camera is designed so that a user can hold the camera using either their right hand or their left hand (col. 4, lines 38-57; figs. 12-14). Therefore, the camera can be grasped by an operator's hand on a region of the front face (X2) and the back (X1). The camera also includes a plurality of switches including a sound recording switch (12) on the front face (X2) of the camera and a release switch (10) on the back face (X1) of the camera (col. 16, line 61 – col. 17, line12; figs. 13,14). The camera also includes a capturing lens (3) provided on the back (X1) and an image monitor (6) that is provided above the sound recording switch (12) and the release

Art Unit: 2612

switch (10) (figs. 13,14; col. 16, lines 61-66). Additionally, the camera includes a plurality of operation switches (Menu, Exec, down arrow, Clear, up arrow, Cancel) disposed in a vicinity of sound recording switch (12) and on the front face (X2) of the vertical body. Although, the release switch (10) is provided on the back face (X1) of the body so that a user can press it with an index finger and the sound recording switch (12) is provided on the front face (X2) of the body so that a user can press it with a thumb (col. 16, line 61- col. 17, line 4), the face (X1,X2) that each switch is provided on is immaterial. The camera would work in the same way if the functions of the two switches were reversed. The important aspect of the invention is that the release switch (10) and the sound recording switch (12) are positioned opposite each other so that there is no obstruction to the lens when holding the apparatus (col. 16, lines 54-60). Therefore, it would have been obvious for one skilled in the art to have been motivated to provide the release switch (10) on the front face (X2) of the body and to provide the sound recording switch (12) on the back face (X1) of the body. Doing so would provide a means for allowing a user to operate the switch on the front face (X2) with their thumb and operate the switch on the back face (X1) with their index finger (Ejima: col. 17, lines 1-4).

### ***Specification***

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 32 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The newly added limitation of claim 32 disclosing "wherein said release switch is disposed at an upper half-region of the vertical body" is not supported in the specification. In figures 1A, 1B, and 2 the release switch (114) is placed in the middle-region of the vertical body. Neither the figures nor the specification indicate that the release switch is disposed at an upper half-region of the vertical body as disclosed in figure 32.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 31, and 33-34 rejected under 35 U.S.C. 103(a) as being anticipated by Ejima et al. US 6229953.**

Ejima discloses in figures 1-2 and 12-14 an electronic camera. The camera includes a front face (X2) (figs. 2, 12, 14) and a back (X1) (figs. 1,13) opposed to the front face. The camera is designed so that a user can hold the camera using either their right hand or their left hand in a grip area which varies depending on where the user is holding the camera (col. 4, lines 38-57; figs. 12-14). Therefore, the camera can be grasped by an operator's hand on a region of the front face (X2) and the back (X1). The camera also includes a plurality of switches including a sound recording switch (12) on the front face (X2) of the camera and a release switch (10) on the back face (X1) of the camera (col. 16, line 61 – col. 17, line12; figs. 13,14). The camera also includes a capturing lens (3) provided on the back (X1) and an image monitor (6) that is provided above the sound recording switch (12) and the release switch (10) (figs. 13,14; col. 16,

Art Unit: 2612

lines 61-66). Additionally, the camera includes a plurality of operation switches (Menu, Exec, down arrow, Clear, up arrow, cancel) disposed in a vicinity of sound recording switch (12) and on the front face (X2) of the vertical body. Although, the release switch (10) is provided on the back face (X1) of the body so that a user can press it with an index finger and the sound recording switch (12) is provided on the front face (X2) of the body so that a user can press it with a thumb (col. 16, line 61- col. 17, line 4), the face (X1,X2) that each switch is provided on is immaterial. The camera would work in the same way if the functions of the two switches were reversed. The important aspect of the invention is that the release switch (10) and the sound recording switch (12) are positioned opposite each other so that there is no obstruction to the lens when holding the apparatus (col. 16, lines 54-60). Therefore, it would have been obvious for one skilled in the art to have been motivated to provide the release switch (10) on the front face (X2) of the body and to provide the sound recording switch (12) on the back face (X1) of the body. Doing so would provide a means for allowing a user to operate the switch on the front face (X2) with their thumb and operate the switch on the back face (X1) with their index finger (Ejima: col. 17, lines 1-4).

Re claim 2, the release switch (10) and the sound recording switch (12) are each positioned at a center in a direction perpendicular to a longitudinal direction of the camera body (figs. 13,14).

Re claim 3, the image monitor (6) is provided on substantially the same plane as the plane on which the sound recording switch (12) is provided (fig. 14).

Re claim 31, operation switches (Clear, Cancel, up arrow) are disposed at an upper half-region of the vertical body (fig. 14).

Re claim 33, LCD (6) is disposed farther from the grip than operation switches (Menu, Exec, down arrow) (fig. 14).

Re claim 34, operation switches (Menu, Exec, down arrow) are disposed within an area to which a user's thumb is reachable when the user grasps a grip area (fig. 14).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



Art Unit: 2612


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly L. Jerabek whose telephone number is **(571) 272-7312**. The examiner can normally be reached on Monday - Friday (8:00 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on **(571) 272-7308**. The fax phone number for submitting all Official communications is 703-872-9306. The fax phone number for submitting informal communications such as drafts, proposed amendments, etc., may be faxed directly to the Examiner at **(571) 273-7312**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600